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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,810	02/09/2004	Clifford E. Gammons	29126.00	9244
22465	7590	04/21/2005	EXAMINER	
PITTS AND BRITTIAN P C P O BOX 51295 KNOXVILLE, TN 37950-1295			PICKETT, JOHN G	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/774,810

Applicant(s)

GAMMONS, CLIFFORD E.

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                                           |                                                                                         |
|-------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                               | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                      | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/9/04</u> | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the curved transition of claims 5, 11 and 13 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 15, 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 recites the limitation "said carrier" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 16 recites the limitation "said carrier" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark et al (US 2003/0234194 A1) in view of King (US 4,901,852).

Regarding claim 17, Clark et al discloses a tubular sheath 101 of flexible material (paragraph [0012]) having an open end 114, a nose end 110, a perimeter (see Figure 1), and a first and second shoulder segment (see Figure 2). Clark et al merely lacks a scalloped shoulder. Clark et al anticipates operating controls of a device through the sleeve (paragraph [0012]).

King discloses scalloping 40 (see Figure 2) for protecting the control while allowing operation of the control (Col. 3, lines 15-20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the sleeve of Clarke et al with a scalloped shoulder as taught by King in order to operate any controls that may be in that location.

As to claim 18, the scalloping of King functions as claimed.

As to claim 19, it would have been obvious to include the scalloping of King on both shoulders in order to operate any controls located in that position. Such scalloping would have an arcuate, convoluted profile.

4. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clark-King as applied to claim 17 above, and further in view of Gammons et al (US 6,224,543 B1).

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Clark-King discloses the claimed invention except for the carrier.

Gammons et al discloses a carrier 26 (see Figure 2) with a sheath releasably secured to the carrier (see for example, Figures 5 and 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the sleeve of Clark-King with a carrier in order to more easily facilitate controller insertion.

5. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark-King as applied to claim 17 above, and further in view of either Gammons et al or Brieske (US 3,954,049).

Regarding claims 1 and 11, Clark-King discloses the claimed invention except for the sheath being formed from a top and bottom panel bonded at their perimeter. Clark teaches a sheath formed via any known manufacturing process (paragraph [0014]).

Both Gammons et al and Brieske disclose known manufacturing processes for forming sheaths in which the sheath is formed from two panels bonded at their perimeter. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the sheath of Clark-King in from two panels bonded at their perimeter in order to enable a continuous fabrication process.

As to claim 2, Gammons et al discloses a carrier 26 (see Figure 2) with a sheath releasably secured to the carrier (see for example, Figures 5 and 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the sleeve of Clark-King-Gammons/Brieske with a carrier in order to more easily facilitate controller insertion.

As to claim 3, Clark et al discloses the parallel side portions as claimed (see Figure 2).

As to claim 4, Clark-King-Gammons/Brieske discloses scalloping in the location claimed.

As to claim 5, Clark et al discloses a curved shoulder (see Figure 2).

As to claim 6, the examiner notes that the controller is not positively claimed. As such, the sheath of Clark-King-Gammons/Brieske is capable of retaining a controller of the claimed structure.

As to claim 7, Gammons et al discloses poly-ether urethane and metalacine. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the sheath in the claimed materials in order to enable sterilization. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Claim 8 is a product-by -process claim. In any event, Brieske discloses heat welding (Col. 1, lines 65-68).

As to claim 9, Gammons et al discloses a carrier with a gloss finish (Col. 3, lines 48-50). The selection of the base material as a paper stock would have been an obvious matter of design choice. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

As to claim 10, Gammons et al is silent on the material of the gloss finish, however the examiner asserts that a polymer gloss was known in the art at the time the invention was made and the selection of such would have been an obvious matter of design choice. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

As to claim 12, King discloses a convoluted profile (see Figure 2).

As to claim 13, Clark et al discloses a curved shoulder and a close fitting sheath (paragraph [0011]).

As to claim 14, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a scalloped portion of the second shoulder in order to enact with any controller in that area of the controlling device.

As to claims 15 and 16, inasmuch as the examiner can determine the scope of claims, the sheath of Clark-King-Gammons/Brieske, as applied to claim 10 above, discloses the claimed invention.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Eva et al and MacGilvary et al appear to disclose sheaths made from two sheets bonded at their edges. Russell discloses a sheath attached to a carrier.





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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Greg Pickett  
Examiner  
13 April 2005

  
Mickey Yu  
Supervisory Patent Examiner  
Group 3700